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Statement of the case.

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RUBBER-TIP PENCIL COMPANY *v.* HOWARD.

Though an idea of a person who afterwards obtains a patent for a device to give his idea effect, may be a good idea, yet if the device is not new his patent is void, even though it be useful. The principle applied to the patent of J. B. Blair, of July 23d, 1867, for a new manufacture, being rubber heads for lead-pencils, and the patent held void as being for nothing more than making a hole smaller than the pencil in a piece of india-rubber and putting the pencil in the hole, the elastic and erasive qualities of india-rubber being known to every one, and every one possessing capacity to make a hole in a piece of rubber, and to put a pencil in the hole, so as to be held there for an eraser by the elasticity of the rubber.

ERROR to the Circuit Court for the Southern District of New York; the case being thus:

On the 23d of July, 1867, J. B. Blair, an artist, alleging himself to be the original and first inventor of "a new and useful rubber head for lead-pencils," received a patent for his invention. His specification and claim were as follows:

"Be it known that I, J. B. Blair, of the city of Philadelphia, &c., have invented a new and useful cap or rubber head to be applied to lead-pencils, &c., for the purpose of rubbing out pencil-marks; and I do hereby declare the same to be fully described in the following specifications and represented in the accompanying drawings, of which—

"Figure 1 is an external view of a pencil as provided with a rubber or elastic erasive head, constructed in accordance with my invention.

"Figure 2 is a longitudinal section of the same.

"Figure 3 shows the head, as made, in a somewhat modified form, or with its upper end terminating in a cone.

"The nature of my invention is to be found in a new and useful or improved rubber or erasive head for lead-pencils, &c., and consists in making the said head of any convenient external form, and forming a socket longitudinally in the same to receive one end of a lead-pencil or a tenon extending from it.

"In the said drawings, A denotes a lead-pencil, and B one of my erasive heads applied thereto. The said head may have a flat top surface, or its top may be of a semicircular or conical

Drawings, attached to the specification.

FIG. 1.

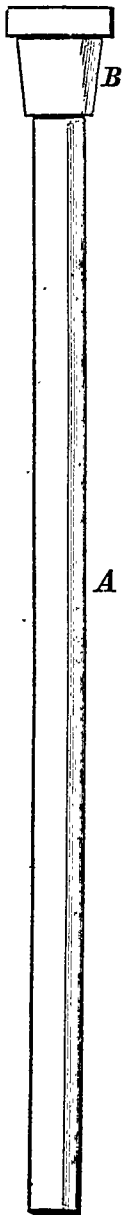


FIG. 2.

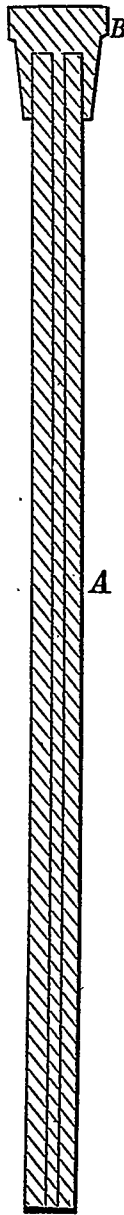
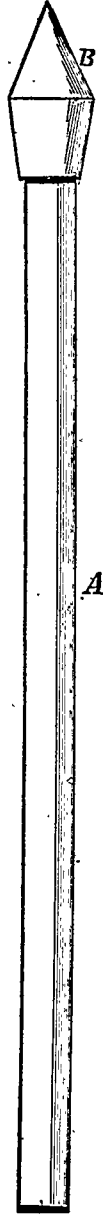


FIG. 3.



## Statement of the case.

shape, or any other that may be desirable. Within one end of the said head I form a cylindrical or other proper-shaped cavity. This socket I usually make about two-thirds through the head, and axially thereof; but, if desirable, the socket or bore may extend entirely through the said head. The diameter of the socket should be a very little smaller than that of the pencil to be inserted in it. The elastic erasive head so made is to fit upon a lead-pencil at or near one end thereof, and to be so made as to surround the part on which it is to be placed, and be held thereon by the inherent elasticity of the material of which the head may be composed. The said head is to be composed of india-rubber, or india-rubber and some other material which will increase the erasive properties of the head.

"The drawings exhibit the elastic head so made as to cover the end as well as to extend around the cylindric sides of the pencil, but it is evident that the contour of the said head may be varied to suit the fancy or the taste of an artist or other person; and I do not limit my invention to the precise forms shown in the drawings, as it may have such or any other convenient for the purpose, so long as it is made so as to encompass the pencil and present an erasive surface about the sides of the same.

"A head made in my improved manner and applied to a pencil as above set forth is of great practical utility and advantage to bookkeepers, accountants, and various other persons. The pointed form of the head, as shown in Figure 3, will be found very useful for draughtsmen in erasing lines from their drawings when it may be desirable not to erase other lines in close proximity to that which it is desirable to erase. The elastic or rubber pencil-head, made as above set forth, may be applied not only to lead-pencils, but to ink-erasers and other articles of like character.

"I claim as a new article of manufacture an elastic erasive pencil-head, made substantially in manner as described.

"J. B. BLAIR."

This patent having become the property of the Rubber-Tip Pencil Company, and one Howard having made, as the company alleged, rubber-tipped pencils like those covered by the patent, the company filed a bill to enjoin him, &c.

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Argument in support of the patent.

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He set up, among other defences, that the article of manufacture claimed as an invention was not patentable as such.

And of this view was the court below. It construed the invention claimed to be "broadly any form which would enable the rubber to encompass a pencil, ink-eraser, or other articles of like character." It said that the additional words, "and present an erasive surface about the sides of the same;" added nothing to the description, because "it was impossible to have a piece of rubber encompass a pencil, ink-eraser, or other article of similar character, without presenting an erasive surface about the sides of the same."

It said further, that the article was not the subject of a patent, because the elastic and erasive properties of india-rubber were known to all; "and that no person knowing the elastic quality of rubber could be wanting in the knowledge that a piece of rubber could be made to encompass and adhere to a pencil by making a hole in it; nor could any one be deficient in the skill requisite to make such a hole."

From a decree accordingly the company took this appeal.

*Mr. J. S. Washburn, for the appellant:*

1. The construction by the court below of the specification and claim is *illiberal* and contrary to the just rule laid down in many cases in this court, including especially a recent one, that patents for invention are to receive a liberal interpretation; and are, if practicable, to be so construed as to uphold and not destroy the right of the inventor.\*

There exists in the present case no necessity which compels an illiberal construction. Indeed, such construction can be sustained only by rejecting the substantial effect of the language of the specification, as explained by the drawings.

The claim is for "an elastic, erasive pencil-head, made *substantially in manner described*." The claim immediately following the description of the invention must be construed

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\* *Klein v. Russell*, 19 Wallace, 433.

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Argument in support of the patent.

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in connection with the explanations contained in the specifications.\*

Now, the specification describes the invention as an "improved" rubber, or erasive head for lead-pencils, and shown in the specification and *drawings* to be a *solid, elastic, socketed, erasive head*, "so made as to fit upon a lead-pencil at or near the end thereof, and to be so made as to surround the part on which it is to be placed, and to be held thereon by the inherent elasticity of the material of which the head may be composed," and having the *projecting, working erasive* surfaces shown in the drawings, which it is stated are "constructed in accordance with my invention," and by which drawings the invention is stated to be "represented."

It is true that the specification says—

"The drawings exhibit the elastic head, so made as to *cover the end* as well as to extend around the cylindric sides of the pencil, but it is evident that the *contour* of said head may be varied to suit the fancy or the taste of an artist or other person; and I do not limit my invention to the *precise* forms shown in the drawings, as it may have such, or any other *convenient for the purpose*, so long as it is made so as to encompass the pencil, and present an erasive surface about the sides of the same."

And from this language the court below assumed that the head might be of *any* external form whatever, so long as it encompasses the pencil, and that the words "and present an erasive surface about the sides of the same" were without any meaning.

But this is a misconception. The language relied on by the court below, and above quoted, should be taken in connection with the language preceding:

"The said head may have a flat *top* surface, or its *top* may be of a semicircular or conical shape, or any other that may be desirable. Within one end of the said head I form a cylindrical or other proper-shaped cavity. This socket I usually make about two-thirds through the head, and axially thereof; but, if desirable, the socket or bore may extend entirely through the said head."

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\* Seymour v. Osborne, 11 Wallace, 547.

## Argument in support of the patent.

The statement in the first above-quoted paragraph, that the *contour* may be varied, and that the inventor does not limit himself to the “*precise*” forms shown in the drawings, is made with reference to the “*end*” of the pencil being covered or uncovered, and is subject to the express condition that the forms shall be “*convenient for the purpose*,” and the implied condition to be fairly derived from the use of the word “*precise*,” that they *must* correspond *substantially* with the *drawings*. There is certainly nothing from which it can be fairly derived that he intended to *disclaim* the features which are clearly portrayed in the drawings, upon which its practical value as an eraser depends; and the use of the words, “to suit the fancy or the taste of an artist or other person,” confines the meaning of the inventor to a matter of *simple style*, and indicates that he does not limit himself to a precise contour as a matter of ornamental configuration. This is further indicated by the fact that, in the drawings, while the *top* of the head is varied and the *contour* of the projecting erasive working surfaces about the sides may be varied from hexagon to square or circular, the projecting, working surfaces themselves are always retained.

It is also evident from the context that the words “and present an erasive surface about the sides of the same” mean *such* erasive surface as is portrayed in the drawings, and as is “*convenient for the purpose*.”

The court below therefore disregarded the drawings. But it is well settled that the drawings constitute a part of the specification, and are to be resorted to to aid a specification, which would otherwise be imperfect; to help out the description; to furnish clearer information respecting the invention described in the specification; to show the nature, character, and extent of the claim, as well as make a *part* of the description; and to *add* anything to the specification which is not specifically contained or mentioned therein.\*

The fact that the construction placed upon the language

\* *Earl v. Sawyer*, 4 Massachusetts, 9; *Burrall v. Jewett*, 2 Paige, 143; *Washburn v. Gould*, 3 Story, 133, 138, 139; *Emerson v. Hogg*, 2 Blatchford, 9; *Hogg v. Emerson*, 6 Howard, 485; 11 Id. 606.

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Opinion of the court.

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in the present case is inconsistent with what the drawings establish, is enough to show it to be a misconstruction.

2. There are certain leading facts, known to everybody, which answer the concluding remarks of the court below, and are of themselves enough to decide this case.

Lead-pencils have very long—longer than any living man remembers—been used to make marks. India-rubber has very long—longer than any living man remembers—been used to rub them out. But never until lately was india-rubber used for this purpose except in a form *disconnected* from the pencil. But on a summer's morning of 1867, one Blair, a poor artist of Philadelphia, seeing that it will be more convenient to use it *on* his pencil than *off*, puts in a certain way, a piece of a certain shape, *on* the pencil, and finding a great advantage in thus using such a piece, shows what he has done. Behold! thousands, hundreds of thousands and millions of rubber-tipped pencils at once appear. Very rich companies, like the Rubber-Tip Pencil Company, are incorporated. Great capital is invested in the matter, and rubber-tipped pencils become a manufacture of the nation. How can it be said that there is no invention here? So far as the patent laws are concerned, *utility*, as ascertained by the consequences of what is done, is the test of invention, and when utility is proved to exist in any great degree, a sufficiency of invention to support the patent must be presumed.\* In such a case it is vain to talk about the small amount of ingenuity shown or to say that the arrangement and application are so simple and obvious that anybody could see them.

*Messrs. F. W. Betts and S. W. Kellogg, contra.*

The CHIEF JUSTICE delivered the opinion of the court.  
The question which naturally presents itself for considera-

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\* *Roberts v. Dickey*, Circuit Court of the United States, Western District of Pennsylvania, per Strong, J., and McKennan, circuit judge, 1 Official Gazette, 4, 5, 6; and see *McCormick v. Seymour*, 2 Blatchford, 243; and *Curtis on Patents*, § 41.

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Opinion of the court.

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tion at the outset of this inquiry is, whether the new article of manufacture, claimed as an invention, was patentable as such. If not, there is an end of the case and we need not go further.

A patent may be obtained for a new or useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof. In this case, as has been seen, Blair's patent was for "a new manufacture," being a new and useful rubber head for lead-pencils. It was not for the combination of the head with the pencil, but for a head to be attached to a pencil or something else of like character. It becomes necessary, therefore, to examine the description which the patentee has given of his new article of manufacture, and determine what it is, and whether it was properly the subject of a patent.

It is to be made of rubber or rubber and some other material which will increase its erasive properties. This part of the invention alone could not have been patented. Rubber had long been known, and so had rubber combined with other substances to increase its naturally erasive qualities.

It is to be of any convenient external form. It may have a flat-top surface, or its top may be of a semicircular or conical shape, or any other that may be desirable. This would seem to indicate clearly that the external form was not a part of the invention. It was, however, urged upon the argument, that the invention did consist in the projecting surfaces extending out from the head, and which appear, as is claimed, in the drawings attached to the specifications. It is true, that in two out of the three drawings projecting surfaces are indicated, but such is not beyond question the case with the third. The shape there shown is conical, extending to a point, and evidently intended to represent the form mentioned as specially adapted to the use of draughtsmen in erasing lines from their drawings. It was the end of such a pencil, not the sides, that was to furnish the particular advantage of form. But although drawings do accompany the specification and are referred to, it is evident



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Opinion of the court.

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that this reference is for the purpose of illustration only, because the patentee is careful to say that "he does not limit his invention to the precise forms shown, as it may have such or any other convenient for the purpose, so long as it is made so as to encompass the pencil and present an erasive surface upon the sides of the same." Certainly words could hardly have been chosen to indicate more clearly that a patent was not asked for the external form, and it is very evident that the essential element of the invention as understood by the patentee was the facility provided for attaching the head to the pencil. The prominent idea in the mind of the inventor clearly was the form of the attachment, not of the head. If additional proof of this is required, it may be found in the further statement in the specifications, which locates the head for use at *or near* the end of the pencil, and so made as to surround the part on which it is to be placed and be held thereon by the inherent elasticity of the material of which it is to be composed. If intended for use at any other place than on the end of the pencil, the projections could not be essential, as any form that would surround the part would present the requisite erasive surface.

Again, the head is to have in it longitudinally, a socket to receive one end of a lead-pencil or a tenon extending from it. This socket is to be cylindrical or of any other proper shape. Usually, the inventor says, he made it so as to extend part way through the head, but if desirable, it might be extended entirely through. It must be within one end, but any particular location at the end is not made essential. This clearly is no more than providing that the piece of rubber to be used must have an opening leading from one end into or through it. This opening may be of any form and of any extent longitudinally. The form, therefore, of the inside cavity is no more the subject of the patent than the external shape. Any piece of rubber with a hole in it is all that is required thus far to meet the calls of the specifications, and thus far there is nothing new, therefore, in the invention. Both the outside and inside may be made of any form which will accommodate the parties desiring the use.

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Syllabus.

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But the cavity must be made smaller than the pencil and so constructed as to encompass its sides and be held thereon by the inherent elasticity of the rubber. This adds nothing to the patentable character of the invention. Everybody knew, when the patent was applied for, that if a solid substance was inserted into a cavity in a piece of rubber smaller than itself, the rubber would cling to it. The small opening in the piece of rubber not limited in form or shape, was not patentable, neither was the elasticity of the rubber. What, therefore, is left for this patentee but the idea that if a pencil is inserted into a cavity in a piece of rubber smaller than itself the rubber will attach itself to the pencil, and when so attached become convenient for use as an eraser?

An idea of itself is not patentable, but a new device by which it may be made practically useful is. The idea of this patentee was a good one, but his device to give it effect, though useful, was not new. Consequently he took nothing by his patent.

The decree of the Circuit Court is

**AFFIRMED.**

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ATCHISON v. PETERSON.

1. On the mineral lands of the public domain in the Pacific States and Territories, the doctrines of the common law, declaratory of the rights of riparian proprietors respecting the use of running waters, are inapplicable or applicable only in a very limited extent to the necessities of miners, and inadequate to their protection; there prior appropriation gives the better right to running waters to the extent, in quantity and quality, necessary for the uses to which the water is applied.
2. What diminution of quantity, or deterioration in quality, will constitute an invasion of the rights of the first appropriator will depend upon the special circumstances of each case; and in controversies between him and parties subsequently claiming the water, the question for determination is whether his use and enjoyment of the water to the extent of the original appropriation have been impaired by the acts of the other parties.